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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,251	11/08/2001	Akira Kuriyama	35.G2932	5033

5514 7590 08/18/2003

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NEW YORK, NY 10112

EXAMINER

MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 08/18/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/986,251

Applicant(s)

KURIYAMA ET AL.

Examiner

Kishor Mayekar

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 28-54 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 & 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of invention of Group I, claims 1-27 and 55 in Paper No. 11 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Objections***

1. Claim 1 is objected to because of the phrase "so as". The phrase needs to be deleted. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102 and § 103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102

Art Unit: 1753

that form the basis for the rejections under this section made in this Office

action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4, 6-8, 27 and 55 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by BEITZEL (4,189,363). See Fig. 1; col. 3, lines 4-24; col. 4, lines 52-63; and col. 6, lines 17-25.

5. Claims 2, 9-19 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over BEITZEL '363. The differences between BEITZEL as applied above and the instant claims are the recitations of the subject to be treated, the functional water, and the manner of operating the device.

As to the recitation of the subject to be treated and the functional water, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified BEITZEL's teachings because it has been held on the intended use of a device that "apparatus claims cover what a device is, not what a device does", *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ 2d 1525 (Fed. Cir. 1990).

As to the manner of operating the device, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified BEITZEL's teachings because the manner in which an apparatus operates is not germane to the issue of patentability of the apparatus itself. *Ex parte Wikdahl* 10 USPQ 2d 1546 (BPAI 1989); *Ex parte McCullough* 7 USPQ 2d 1889 (BPAI 1988); *In re Finterswalder* 168 USPQ 530 (CCPA 1971); *In re Casey* 152 USPQ 235 (CCPA 1967).

Art Unit: 1753

6. Claims 20 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over BEITZEL '363 in view of HOSEN et al. (6,217,834). The difference between BEITZEL as applied above and the instant claims is that BEITZEL is silent on the wavelength of the light. HOSEN shows in treatment system of fluids by UV light shows that it is known to employ a UV light to emit radiation in a range of wavelengths between 185 and 400 nm (col. 1, lines 13-20). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified BEITZEL's teachings as shown by HOSEN because the selection of any known equivalent light wavelength to treat fluids would be within the level of ordinary skill in the art.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over BEITZEL '363 as applied to claims 2, 9-19 and 22-26 above, and further in view of TAO et al. (6,299,844). The difference between BEITZEL as applied above and the instant claims is the use of a reflective film formed on the outer surface of the case. TAO shows in a fluid treating device with UV light the use of a light-reflecting surface formed on a case (col. 3, lines 42-55). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time

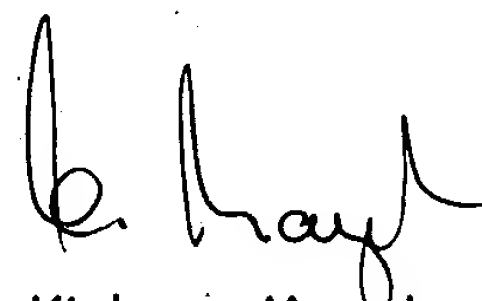
Art Unit: 1753

the invention was made to have modified BEITZEL's teachings as shown by TAO because the selection of any known equivalent placement of a light reflecting surface to a case would be within the level of ordinary skill in the art.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (703) 308-0477. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Kishor Mayekar  
Primary Examiner  
Art Unit 1753

Application/Control Number: 09/986,251

Page 7

Art Unit: 1753

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August 12, 2003